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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/822,682	04/13/2004	Eric Bercklouw	2001-1105-1	2986
466	7590	05/21/2007		
YOUNG & THOMPSON 745 SOUTH 23RD STREET 2ND FLOOR ARLINGTON, VA 22202			EXAMINER BLANCO, JAVIER G	
			ART UNIT 3738	PAPER NUMBER
			MAIL DATE 05/21/2007	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

10/822,682

Applicant(s)

BERREKLOUW, ERIC

Examiner

Javier G. Blanco

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 06 March 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 72-83,85-90 and 92-121 is/are pending in the application.
- 4a) Of the above claim(s) 76,78-83,85-87,89,90 and 92-121 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 72-75,77 and 88 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Response to Amendment***

1. Applicant's amendment of claims 72-83 and 85-90 in the reply filed on March 6, 2007 is acknowledged.
2. Applicant's cancellation of claims 84 and 91 in the reply filed on March 6, 2007 is acknowledged.
3. Applicant's addition of claims 120 and 121 in the reply filed on March 6, 2007 is acknowledged. Said claims depend on withdrawn claims 78 and 82, and are hereby withdrawn from further consideration.

### ***Claim Objections***

4. Claims 72 and 88 are objected to because of the following informalities:
  - a. Regarding claim 72, please substitute "and to accommodate a prosthesis" (see line 6) with --and to accommodate a said valve prosthesis --. Appropriate correction is required.
  - b. Regarding claim 88, please substitute "the inserted position" (see line 9) with --the inserted fixing position--. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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6. Claims 72-75, 77, and 88 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

a. Regarding claim 72, "the peripheral wall" (see line 9) lacks antecedent basis. Claims 73-75, 77, and 88 depend on claim 74.

b. Regarding claim 88, the last four lines of said claim render claim 88 indefinite as to the scope of the invention. Since the claim language is an English translation of a foreign application, said (functional) limitation is unclear and indefinite.

***Claim Rejections - 35 USC § 102***

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 72-75, 77, and 88 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Shiley (US 3,686,740 A; cited in Applicant's IDS).

Referring to Figures 5-7, 9, and 25-30, Shiley discloses a prosthesis fixing device comprising a tubular element (outer ring 11 + inner ring 12), capable of accommodating a prosthesis (e.g., valve 15), having pins (pins 13) distributed around the periphery of said tubular element, said pins having pointed ends, wherein each pin is arranged on an arm which arm, via a fold or bend line, is attached by one end to the tubular element, wherein the arms and pins are capable of moving, by swinging about the fold or bend line, from an insertion position (e.g.,

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Figure 5), in which they are ESSENTIALLY located inside the tubular element, to a fixing position (e.g., Figure 6) in which at least the pins project outside of the tubular element. Each of wire suture pins 13 comprises a basal end 43, a body portion 50, and a distal end 49. The tubular element is provided with slit-shaped radial passages (radial slots 35, annulus 52, and/or apertures 41) located alongside the pins in the radial direction.

**Note:** Claims directed to apparatus must be distinguished from the prior art in terms of structure rather than function. *In re Danly*, 263 F.2d 844, 847, 120 USPQ 528, 531 (CCPA1959).

“[A]pparatus claims cover what a device is, not what a device does.” *Hewlett-Packard Co. v. Bausch & Lomb Inc.*, 909 F.2d 1464, 1469, 15 USPQ2d 1525, 1528 (Fed. Cir. 1990).

Expressions relating the apparatus to contents thereof during an intended operation are of no significance in determining patentability of the apparatus claim. *Ex parte Thibault*, 164 USPQ 666, 667 (Bd. App. 1969).

### ***Response to Arguments***

9. With regards to the 102(b) rejection based on Shiley (US 3,686,740 A; cited in Applicant's IDS), Applicant's arguments filed March 6, 2007 have been fully considered but they are not persuasive.

a. Regarding claim 72, the Applicant argues that Shiley does not disclose: “*in which they are essentially located inside the tubular element, into a fixing position in which at least the pins, viewed in the radial direction, project outside the tubular element*” (“they” refers to the arms and pins). The Examiner respectfully disagrees. As noted above, the Examiner is broadly interpreting outer ring 11 + inner ring 12 (or outer ring 111 + inner ring 112) as the “tubular element” (i.e.,

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both rings, as a unit, form a tubular element). In the insertion position (e.g., Figure 5), the arms and pins (pins 13) are ESSENTIALLY located inside the tubular element. Each of wire suture pins 13 comprises a basal end 43, a body portion 50, and a distal end 49. These portions/ends of the pins are located inside the tubular element. In the “fixing position” (e.g., Figure 6), the pins project outside of the tubular element.

b. Regarding the “bend line”, both of Figures 5 and 6 clearly show the arms and pins as movable about a bend line. It is noted that the pins are not straight, but have a curve/bend profile. The Applicant argues that: “swinging means that the movement is a swivel/hinge action around an axis”. The Examiner respectfully disagrees. The motion/movement depicted in Figures 5 and 6 could be broadly considered “by swinging”. Additionally, the swinging motion could also develop at the bend line between distal end 49 and body portion 50 (see Figure 7). Further, claims directed to apparatus must be distinguished from the prior art in terms of structure rather than function. *In re Danly*, 263 F.2d 844, 847, 120 USPQ 528, 531 (CCPA1959). “[A]pparatus claims cover what a device is, not what a device does.” *Hewlett-Packard Co. v. Bausch & Lomb Inc.*, 909 F.2d 1464, 1469, 15 USPQ2d 1525, 1528 (Fed. Cir. 1990). Expressions relating the apparatus to contents thereof during an intended operation are of no significance in determining patentability of the apparatus claim. *Ex parte Thibault*, 164 USPQ 666, 667 (Bd. App. 1969).

### ***Conclusion***

10. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Javier G. Blanco whose telephone number is 571-272-4747. The examiner can normally be reached on M-F (9:30 a.m.-7:00 p.m.), first Friday of the bi-week off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Corrine McDermott can be reached on (571) 272-4754. The fax phone numbers for the organization where this application or proceeding is assigned is 571-273-8300 for regular communications and After Final communications. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0858.

Javier G. Blanco

May 9, 2007



David H. Willer  
Primary Examiner